UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,377	10/22/2001	Kenneth J. Galipeau	14113.57.1.1	9767

22913 7590 10/25/2002

WORKMAN NYDEGGER & SEELEY
1000 EAGLE GATE TOWER
60 EAST SOUTH TEMPLE
SALT LAKE CITY, UT 84111

EXAMINER
LE, DIEU MINH T

ART UNIT	PAPER NUMBER
2184	

DATE MAILED: 10/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/004,377	GALIPEAU ET AL.	
	Examiner	Art Unit	
	Dieu-Minh Le	2184	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 January 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *2* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

Part III DETAILED ACTION

Specification

1. Claims 1-22 are presented for examination.

Double Patenting Rejections

2. Claim 1-22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. patent 5,799,141 and claims 1-17 of U.S. patent 6,308,283B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed subject matter contains obvious modifications to previous claims 1-14 of U.S. patent 5,799,141 and claims 1-17 of U.S. patent 6,308,283B1.

As to claims 1, 11, 17 these claims include limitations of: local computer system, remote computer system, a network, and change information, which already included in claims 1-14 of U.S. patent 5,799,141 and claims 1-17 of U.S. patent 6,308,283B1. It is well settled that the omission of an element and its function [i.e.,mirroring driver] is an obvious expedient if the remaining

elements perform the same function as before. In re Karlson, 136, USPQ 184 (CCPA 1963). Also note Ex parte Rainu, 168 USPQ 375 (Bd. App. 1969). Therefore, omitting various elements from the previous claimed subject matter would have been obvious to one of ordinary skill in the art in this case since the remaining elements do in fact perform the same functions as before. Elimination/Changing of an element or its function will not serve as a basis for patentability.

4. The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. *In re Vogel*, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at

the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cheffetz in view of Yanai (US Patent 5,544,347).

As to claims 1-5, 10, Cheffetz teaches a computer network which includes local and remote computers (See Abstract and Figure). Cheffetz also teaches that the local computer has no

data protection code and that the remote computer stores backup copies of selected data files which are transmitted across the network from the local computer (col. 3, lines 17-27). Cheffetz does not explicitly teach that change information representing an individual change to a data file is transmitted across the network.

However, Yanai teaches a computer network in which a high speed data link transfers changes made to the primary storage system to a secondary storage system (Yanai - col. 5, line 52 to col. 6, line 25 and col. 5, lines 37-50). It would have been obvious to one of ordinary skill in the art to combine the teachings of Cheffetz and Yanai because both inventions deal with providing a data backup in a computer network. The combination would further have been obvious because sending only change information from the primary to secondary storage system is a way in which to save unnecessary data processing/transmission time because if no changes are made to the file, then no data needs to be transmitted. Therefore, transmitting only change information, as taught by Yanai, in the backup computer system of Cheffetz would have been an obvious way in which to maintain data backup in a time saving manner. Further, the modifications required to

Cheffetz would have been well within the skill of a person of ordinary skill in the art.

As to claims 6, Yanai teaches that the change information is transmitted concurrently with the change being made at the local computer (Yanai - col. 8, lines 60-65).

As to claims 7, Yanai teaches that the primary computer system maintains a log of primary data which is to be copied to the secondary (remote) computer system (Yanai - col. 2, lines 57-62).

As to claims 8 Yanai teaches that the remote computer system transmits an acknowledgment to the local computer system after receiving the change information (Yanai - col. 2, lines 63-67).

As to claims 9, neither Cheffetz or Yanai explicitly teach using a network server connecting the local stations or that a network interface is used for transmitting the information across the network. However, it would have been obvious to use such connections because both Cheffetz and Yanai do operate in a local area network environment and using servers and interfaces are the most common devices used in this field to interconnect the

computers. Further, the network server and interface would be required in order for common local area networks such as Cheffetz to operate properly and therefore would have been obvious additions to Cheffetz.

As to claims 11, 14-16 these claims encompass the same scope as claims 1-10 and are rejected for the reasons given in paragraphs above.

As to claims 12, 18-19, neither Yanai or Cheffetz explicitly teach that the individual change is a write operation or a file operation. Yanai more generally teaches that the change information is any change in the selected file. It would have been obvious to one of ordinary skill in the art to back-up the change for write or file operations because both of these are standard operations which would be expected to be included in the back-up computer of the Cheffetz/Yanai combination in order to have a mirrored back-up copy.

As to claim 13, neither Cheffetz or Yanai explicitly teach using a mirror driver for storing the change information in the log file. However using a separate driver for the file system on

the local computer and the log file merely allows the data to be stored in a more timely manner. This is due to the fact that with separate drivers, the data can be stored on the log at the same time it is stored in the local computer. One of ordinary skill in the art would have been aware of this time-saving benefit and the modifications to the prior art would have been well within the skill of such a person.

As to claims 17, 20-22, see paragraphs above for the detailed discussion of the teachings of cheffetz and Yanai as well as the motivation to combine these teachings.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

7. A shortened statutory period for response to this action is set to expired THREE (3) months, ZERO days from the date of this letter. Failure to respond within the

period for response will cause the application to be abandoned. 35 U.S.C. 133.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dieu-Minh Le whose telephone number is (703) 305-9408. The examiner can normally be reached on Monday-Thursday from 6:30 AM to 4:00 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Beausoliel, can be reached on (703)305-9713. The fax phone number for this Group is (703) 305-3718.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 746-7239, (for formal communications intended for entry)

Or:

(703) 746-7240 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

DIEU-MINH THAI LE
PRIMARY EXAMINER
ART UNIT 2184

DML
October 22, 2002